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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,619	06/18/2001	Robert Martin Wynalda JR.	1949-A-CIP	5116

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EXAMINER

SIMONE, CATHERINE A

ART UNIT PAPER NUMBER

1772

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,619

Applicant(s)

WYNALDA ET AL.

Examiner

Catherine Simone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/20/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 6-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-15 is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6 and 16-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/20/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Withdrawn Rejections

1. The 35 U.S.C. 102 rejection of claim 1 as anticipated by Hanselmann of record in the Office Action mailed 3/16/04, Pages 5-6, Paragraph #13 has been withdrawn due to the Applicant's amendment filed 9/20/04.
2. The 35 U.S.C. 102 rejection of claims 1, 17, 18 and 21 as anticipated by Dudzik of record in the Office Action mailed 3/16/04, Pages 6-7, Paragraph #14 has been withdrawn due to the Applicant's amendment filed 9/20/04.

Repeated Rejections

3. The 35 U.S.C. 102 rejection of claims 1-6, 10, 16-19, 21 and 22 as anticipated by Brinkhurst (GB 2 274 452) is repeated for the reasons previously set forth in the Office Action mailed 3/16/04, Pages 3-5, Paragraph #11.
4. The 35 U.S.C. 102 rejection of claims 1-6 as anticipated by Brinkhurst (GB 2 274 450) is repeated for the reasons previously set forth in the Office Action mailed 3/16/04, Page 5, Paragraph #12.
5. The 35 U.S.C. 103 rejection of claims 8, 9 and 12-15 over Brinkhurst '452 or Brinkhurst '450 in view of Youngs is repeated for the reasons previously set forth in the Office Action mailed 3/16/04, Pages 7-8, Paragraph #16.
6. The 35 U.S.C. 103 rejection of claim 11 over Brinkhurst '452 or Brinkhurst '450 in view of Udwin et al. is repeated for the reasons previously set forth in the Office Action mailed 3/16/04, Pages 8-9, Paragraph #17.

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5. The 35 U.S.C. 103 rejection of claims 20 and 23 over Brinkhurst '452 or Brinkhurst '450 in view of Youngs is repeated for the reasons previously set forth in the Office Action mailed 3/16/04, Pages 9-10, Paragraph #18.

New Rejections

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
7. **Claims 24 and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Brinkhurst (GB 2 274 450) or Brinkhurst (GB 2 274 452) in view of Hanselmann (US 1,186,312).

As previously shown, Brinkhurst '452 and '450 each disclose the present invention as claimed in claims 1 and 19. However, each fails to disclose the page being entirely disposed between the front and rear covers in the closed position. Hanselmann teaches that it is old and well-known in the art to have a page (Fig. 1, D) adapted to hold recorded media being entirely disposed between the front and rear covers (Fig. 1, A and A') in the closed position for the purpose of forming a storage container for holding items of recorded media. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the page in either

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Brinkhurst '450 or Brinkhurst '452 to be entirely disposed between the front and rear covers when the covers are in the closed position as suggested by Hanselmann in order to produce a storage container for holding items of recorded media.

8. **Claim 26** is rejected under 35 U.S.C. 103(a) as being unpatentable over Brinkhurst (GB 2 274 452) or Brinkhurst (GB 2 274 450) in view of Youngs (US 4,850,731) and in view of Hanselmann (US 1,186,312).

As previously shown, Brinkhurst '452 or Brinkhurst '450 in view of Youngs teaches the present invention as claimed in claim 20. However, Brinkhurst '450 and Brinkhurst '452 each fails to disclose the page being entirely disposed between the front and rear covers in the closed position. Hanselmann teaches that it is old and well-known in the art to have a page (Fig. 1, D) adapted to hold recorded media being entirely disposed between the front and rear covers (Fig. 1, A and A') in the closed position for the purpose of forming a storage container for holding items of recorded media. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the page in either Brinkhurst '450 or Brinkhurst '452 to be entirely disposed between the front and rear covers when the covers are in the closed position as suggested by Hanselmann in order to produce a storage container for holding items of recorded media.

Allowable Subject Matter

9. Claims 7-15 are allowed. The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record fails to teach or suggest the recited structure for a storage container. Independent claim 7 identifies the

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uniquely distinct feature of “the edge of the page connected to the cover being V-shaped in cross section to provide a pocket for the adhesive.” The closest prior art of record, Brinkhurst (GB 2 274 450) and Brinkhurst (GB 2 274 452), discloses a storage container comprising a front cover member and a rear cover member and a spine between the front and rear cover members and further a page having at least one edge connected to the spine, which either singularly or in combination, fail to anticipate or render obvious the above limitation.

Response to Arguments

10. Applicant's arguments filed 9/20/04 have been fully considered but they are not persuasive. Applicant argues that “the Brinkhurst publications only disclose the possibility of an adhesive tape in combination with the resilient clips (23 and 24) that are disclaimed in the independent claims of this application. The material cited by the Examiner on pages 4 and 5 of the references only speculates that an adhesive tape “may be possible.” Such speculation cannot be used as a disclosure to anticipate a claim. All of the Brinkhurst embodiments disclosed in the publications use the external clips (23 and 24) to hold the covers in place.”

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., “adhesive”) is not recited in the rejected claim 1. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, regarding independent claims 19 and 20, the Brinkhurst publications clearly teach the use of an adhesive to connect the page to the cover (see Brinkhurst '452 page 4, line 26 to page 5, line 2 and see page 9, lines 19-25; and see Brinkhurst '450 page 4, lines 12-15). Even though the Brinkhurst publications disclose "it may be possible" to use an adhesive, the adhesive is still being taught. Therefore, the Brinkhurst publications clearly teach an adhesive as claimed in the present invention.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571)272-1501. The examiner can normally be reached on 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Catherine Simone
Examiner
Art Unit 1772
November 18, 2004


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

11/24/04